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EXAMINER

LIE, ANGELA M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/039,341	Applicant(s) THOMAS, C. DOUGLASS	
	Examiner ANGELA M. LIE	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 31-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

1. Claims 1-27 and 31-37 are pending.
2. Claims 28-30 are canceled.
3. Claims 1-27 and 31-37 are rejected under 35 U.S.C 103(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-8, 10-21, 23-25, 31, 32, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardos et al (US Patent No. 7251826), hereafter referred to as Gardos, in view of Meunier et al (US Patent No. 6681369), hereafter referred to as Meunier.**

As to claims 1, 13, 20 and 32, Gardos teaches a method for monitoring, the domain space including at least one domain variation of the name to be monitored, the method comprising: (a) receiving a request to monitor a name (Figure 2); (b) determining a domain space about the name to be monitored, the domain space including at least one domain variation of the name to be monitored (Figures 5 and 6, wherein all the alias can be determined (i.e. host names)); (c) searching a database of domain name registrations to identify one or more registrations of domain names that match the at least

one variation of the name being monitored (Figures 5, 6, 7, 9 and 10, wherein all the information identified for each of the domain and their alias is part of registration information such as IP number, associated mail servers etc); and (d) notifying the requestor of the identified one or more registrations (Figures 5-10, wherein all the information is displayed to a user, in other words the user is notified). Gardos however does not explicitly teach that subsequent to the receiving (a) of the request to monitor the name, the searching (c) and the notifying (d) are periodically automatically performed. On the other hand, Meunier teaches monitoring agent which automatically tracks changes in documents (information) (column 5, lines 29-48), by periodically accessing the document or information and then notifying a user about the changes (column 5, lines 49-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Gardos about monitoring domain registration information with Meunier's teaching about performing requested action periodically in order to provide the most current information to a user, without one's intervention. In result this would save a lot user's time.

With respect to claim 11, Gardos also teaches sending warning messages to registrants of the identified one or more registrations (Figure 4, wherein a warning message is sent to inquire a registrants/customer in order to identify whether or not a requestor is authorized to modify domain name zone file).

With respect to claims 5, 6, 17, 18, 20 and 32, Gardos further teaches the name to be monitored being a character string (Figure 5, wherein "victoriakarol.com" is clearly a character string), and wherein the identified one or more registrations of domain

Art Unit: 2163

names that are similar to the that of the name are those that include the character string as well as at least one additional character not in the character string (Figure 5, wherein remaining host names (i.e. variations) all have “victoriakarol.com” in them plus additional characters).

As to claims 2 and 14, Meunier further teaches a method wherein the notifying (d) is performed by electronic mail (column 5, lines 49-56).

As to claims 3 and 16, Gardos teaches a method wherein the name pertains to a domain name (Figure 6, wherein “victoriakarol.com” is a domain name).

As to claims 4 and 15, Gardos teaches a method wherein the searching (b) searched plurality of databases of domain name registrations (column 8, lines 1-9).

As to claims 7 and 19, Gardos teaches a method wherein the searching (c) searches recent registrations (Figure 5, wherein listed domain include all relevant registrations, including both recent and non-recent).

As to claims 8 and 21, Gardos teaches the method wherein the notifying (d) comprises: (d1) producing a notification message pertaining to the identified one or more registrations (figure 5, wherein all the information listed is considered a notification); and (d2) forwarding the notification message to the requestor (Figure 5, wherein those information is displayed in this form to a user).

As to claims 10, 23 and 31, Gardos teaches the method wherein the receiving (a) comprises receiving monitoring request data from a requestor, the monitoring request data being provided through interaction with a web site accessible via the Internet (column 5, lines 3-8).

As to claims 12, 24, 25, 34 and 37, Meunier further teaches a method wherein the sending (d) of the warning messages is done automatically for the requestor or on specific request by the requestor (column 5, lines 49-56, wherein a notification is sent once a requestor attempts to modify domain specific information).

6. **Claims 9, 22, 26, 27, 33, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardos et al (US Patent No. 7251826), hereafter referred to as Gardos, in view of Meunier et al (US Patent No. 6681369), hereafter referred to as Meunier, and further in view of Hollenbeck et al (US Publication No. 2005/0102354), hereafter referred to as Hollenbeck.**

As to claims 9 and 22, Gardos and Meunier teach all the limitation disclosed in claims 1 and 21 respectively. Gardos also teaches notification message including at least registrant, however neither Gardos, nor Meunier expressly teach that the message also includes date of registration and contact information for each identified registrations. On the other hand, Hollenbeck teaches shared registration system for registering domain names, wherein information about the registrar includes contact information and date of creation (Figure 9, element 902). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine modified Gardos's domain look-up system with Hollenbeck's teaching about providing contact and account creation information, in order to supply more detailed information which would allow a requestor to easily contact a person in charge of a specific domain and also get familiar with history of the account, which might be useful in identifying whether or not there is anything faulty with the account.

As to claims 26 and 35, Gardos and Meunier teach all the limitations disclosed in claims 1 and 13 respectively, however they do not expressly teach monitoring activation of a website at the domain names of the identified one or more registrations. On the other hand, Hollenbeck teaches a system wherein customer service can view status (i.e. monitor) of a website/domain registration at any time (i.e. from activation to as long the domain name is active) (paragraphs [0057], [0073] and [0078]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to monitor activation of a website/domain name, as taught by Hollenbeck in modified Gardos's domain look-up system, in order to allow customer service to track and identify potential error associated with an activation and to also to properly maintain billing information.

As to claims 27, 33 and 36, Hollenbeck further teaches informing a requestor of the activation of a website at the domain names of the identified one or more registrations (paragraphs [0057], [0073] and [0078], wherein status information is sent to a requestor (for instance customer service representative), further wherein domain name corresponds to a website, thus creation of a domain name is considered equivalent to activating a website).

Response to Arguments

7. Applicant's arguments filed February 26, 2009 have been fully considered but they are not persuasive.

8. *In the first argument on page 3, the Applicant contends that "Gardos describes a system and method for managing existing domains. Hence, the domain name entered using Fig. 2 is to manage of such domain. In contrast, the claim 1 is monitoring domain name registrations, Gardos offers merely management of existing domains, not monitoring for domain name registrations".*

9. The Examiner disagrees with the Applicant's assertion. Term "monitoring" is very vague. In particular, current claim language does not include any language that would clearly point out what the "monitoring" involves. Consequently, as long a user can access data about plurality of domain names or if a user is capable of frequently looking up information, he/she monitors the domain name database. Furthermore, the Applicant contends that current invention, as claimed, monitors domain name registrations while Gardos teaches managing existing domains. Again, the Examiner disagrees. Gardos teaches looking up and searching domain registrations, however it appears that this is exactly what the Applicant describes in the claims. In other words a user inputs a domain name and the database is searched. Hence, the Examiner does not recognize any difference between the search described in the claims and the search conducted by Gardos.

10. *Then in the following paragraph on page 3, the Applicant alleges that Gardos does not teach "determining a domain space about the name to be monitored, the domain space including at least one domain variation of the name to be monitored", be because Fig. 5 merely allows a user to assign aliases to a particular domain*

[victoriakarol.com], and Fig. 6 merely allows a user to specify mail servers for this particular domain”.

11. The Examiner disagrees with the Applicant's assertion. In particular Figures 5 and 6 of Gardos clearly illustrate multiple instances of aliases associated with domain name “victoriakarol.com”. Furthermore, the aliases are slight variations of the name to be monitored (i.e. entered by a user as shown in figure 2). Accordingly, the Examiner maintains that Gardos does teach “*determining a domain space about the name to be monitored, the domain space including at least one domain variation of the name to be monitored*”, wherein domain space is considered to include other host names as well as IP addressed corresponding to those domain names.

12. *Moving on to the next page, the Applicant argues that “Gardos, however, offers no teaching or suggestion for “searching a database of domain name registrations to identify one or more registrations of domain names that match the at least one variation of the name being monitored”.*

13. The Examiner disagrees with the Applicant's allegation. As illustrated in figures 5 and 6, ISP Manager allows entering a search (Figure 2) which results in retrieval of plurality of variations of domain name registrations that can be monitored. This in fact does not appear to be any different from what is currently claimed.

14. *Then in the next paragraph on page 4, the Applicant contends that “nothing in Gardos teaches or suggest anything about notifying a requester of one or more registrations that are identified by the searching of element (c)”.*

Art Unit: 2163

15. The Examiner disagrees with the Applicant about the above issue. As explained in the rejection, notifying requester of one or more registrations could be interpreted as displaying the result in response to the conducted search. Hence the Examiner maintains that Gardos teaches “notifying a requester of one or more registrations”.

16. *Also on page 4, the Applicant argues that there is “no rational reason as to why one skill in the art would seek to combine the domain management of Gardos with the document recommendation (e.g., document change information) of Meunier”*

17. In response to applicant's argument that there is no rational reason to combine the domain management of Gardos with the document recommendation of Meunier, since it is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992). In this case, the primary prior art (i.e. Gardos) does not teaches plurality of steps being automatically repeated, however on the other hand Meunier teaches plurality of steps being performed periodically in order to determine whether there were any changes made to the data. Even though Meunier's art does not teach domain registration, the idea of performing predefined steps periodically in order to maintain most up-to-date data is well known, and in this case Meunier's art has been used to support that statement. Moreover, Meunier is not required to teach all of the limitations currently disclosed in claims because it has been used here as secondary

Art Unit: 2163

art. Consequently, the Examiner maintains that Gardos' and Meunier's teachings have been properly combined.

18. *Then on page 5, the Applicant alleges that " Fig. 4 mentions an authorization email being sent; however, an authorization email such as used in Gardos is not a warning message to registrants of those one or more registrations that have been identified by the searching as matching the name being monitored".*

19. The Examiner disagrees with the Applicant's assertion. As disclosed in the most recent non-final rejection, the message illustrated in figure 4 is an example of warning message sent to a person attempting to search registrations database for a particular domain name. Moreover, the Examiner would like to note that the claim language does not teach what the warning message is about and it lacks any details which would allow to disqualify the existing prior art. Furthermore, in column 9, lines 20-30, Gardos teaches an operator who represents a group of registrants (i.e. agent), thus any communication sent to him from the domain manager is considered sending a warning (in case of error) message to registrants identified via search. Consequently, the Examiner maintains that Gardos does indeed teach sending a warning message to "registrants of those one or more registrations that have been identified by the searching".

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2163

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiry

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA M. LIE whose telephone number is (571)272-8445. The examiner can normally be reached on M-F.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2163

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Angela M Lie/
Examiner, Art Unit 2163

/don wong/

Supervisory Patent Examiner, Art Unit 2163